UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/654,469	09/01/2000	Shigenori Yamasaki	9281/3751	6062

757 7590 09/21/2004

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

EXAMINER	
SHIMIZU, MATSUICHIRO	

ART UNIT	PAPER NUMBER
2635	

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/654,469	YAMASAKI ET AL.	
	Examiner	Art Unit	
	Matsuichiro Shimizu	2635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 June 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Amendment

The examiner acknowledges amended claims 1-2,6,11-12,16,21-22 and 26.

The examiner withdraws the objection to claims 1, 11 and 21 in view of corrected spelling provided by the applicant filed on 6/29/2004.

The examiner acknowledges amendment to the specification and approves of its amendment. Therefore, it is "OK" to enter.

Response to Arguments

Applicant's arguments with respect to claims 1-2, 6, 11-12, 16, 21-22 and 26 have been considered but are moot in view of the new grounds of rejection including new prior art of Nomura.

Therefore, rejection of claims 1-30 follows:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner

to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marino et al. (6,026,165) in view of Nomura (5,267,299).

Regarding claim 1, Marino teaches a communication apparatus, comprising:

a portable transmitter (Figs. 1-2, col. 6, lines 21-42, transmitters 2a-b) including: at least one operating switch (Figs. 1-2, col. 6, lines 21-42, keys 3 for inputting a personal identification number),

a first storing unit containing an ID code (Fig. 2, device ID 30),

a first control unit (Fig. 2, encryption logic 22) , and a transmitting unit (Fig. 2, to RF XMTR) to transmit an electromagnetic signal having the ID code (Fig. 2, to RF xmtr); and

a receiver (Fig. 3, from RF receiver) including: a receiving unit to receive the electromagnetic signal having the ID code, a second storing unit (Fig. 3, EEPROM 42) containing a reference code stored therein, and a control signal generating unit (Fig. 3, decrypted data to control unit out of module 44); said receiver comparing said ID code within the electromagnetic signal with said reference code and supplying control signals from said control signal generating unit to a controlled device when said ID code and said reference code match (col. 8, lines 3-12, GO signal to the control when matching);

when said first control unit is set to the ID registration mode by said ID registering mode setting mechanism (col. 8, lines 54-66, depressing three keys at once in order to trigger programming mode) and said at least one operating switch is operated (col. 8, lines 54-66, depressing three keys at once in order to trigger

programming mode), the ID code sections are supplied said first storing unit to register as said ID code (col. 8, lines 54-66, depressing three keys at once in order to trigger programming mode). But Marino does not teach a first storing unit containing an ID code registered therein, the ID code including a plurality of ID code sections forming one ID code as a whole, each ID code section being generated corresponding to an operation of said at least one operating switch; and when said first control unit is set to the ID registration mode by said ID registering mode setting mechanism and said at least one operating switch is operated, the ID code sections are supplied said first storing unit to register as said ID code.

However, Nomura teaches, in the art of ID registration system, a first storing unit containing an ID code registered therein, the ID code including a plurality of ID code sections (col. 5, lines 8-24, code section for each number in first memory as a registered code 160) forming one ID code as a whole, each ID code section being generated corresponding to an operation of said at least one operating switch (col. 5, lines 8-24, ten-key pad 140); and when said first control unit is set to the ID registration mode by said ID registering mode setting mechanism (col. 5, lines 8-24, registration mode via switch 150) and said at least one operating switch is operated, the ID code sections are supplied said first storing unit to register as said ID code (col. 5, lines 8-24, first memory as a registered code 160) for the purpose of preventing unauthorized person from using the remote control. Therefore, it would have been obvious to a person skilled in the art at the time the invention was made to include a first storing unit containing an ID code registered therein, the ID code including a plurality of ID code sections forming one ID code as a whole, each ID code section being generated corresponding to an operation of said at least one operating switch;

and when said first control unit is set to the ID registration mode by said ID registering mode setting mechanism and said at least one operating switch is operated, the ID code sections are supplied said first storing unit to register as said ID code in the device of Marino because Marino suggests a first storing unit containing an ID code and Nomura teaches a first storing unit containing an ID code registered therein, the ID code including a plurality of ID code sections forming one ID code as a whole, each ID code section being generated corresponding to an operation of said at least one operating switch; and when said first control unit is set to the ID registration mode by said ID registering mode setting mechanism) and said at least one operating switch is operated, the ID code sections are supplied said first storing unit to register as said ID code for the purpose of preventing unauthorized person from using the remote control.

Regarding claim 2, Marino teaches a communication apparatus according to claim 1, wherein said at least one operating switch is operated multiple times before the ID code sections register as said ID code (col. 8, lines 54-66, depressing three keys at once in order to trigger programming mode).

Regarding claim 3, Marino teaches a communication apparatus according to claim 2, wherein the ID code sections are sequentially supplied to said first storing unit (col. 8, lines 54-66, depressing three keys at once in order to trigger programming mode wherein eeprom 26 stores ID code sequentially).

Regarding claim 4, Marino teaches a communication apparatus according to claim 1, wherein said ID registration mode setting mechanism comprises said at least one operating switch and a mode control unit within said first control unit to set the ID registration mode from the operation of said at least one operating switch in a

predetermined format (col. 8, lines 54-66, depressing three keys at once or predetermined format in order to trigger programming mode or registration mode wherein EEPROM 26 stores ID code sequentially).

Regarding claim 5, Marino teaches a communication apparatus according to claim 4, further comprising at least two operating switches, said ID registration mode setting mechanism further comprising operation of said at least two operating switches in a predetermined order (col. 2, lines 23-26, predetermined order associated with registration mode button before receiving ID; col.3, line 6-13, operation of call via specific master by transmitting specific ID).

Regarding claim 6, Marino teaches a communication apparatus according to claim 1, further comprising a clock generating unit to generate clock signals (col. 7, lines 51-56, clock associated with a counter); and a counter (col. 7, lines 51-56, clock associated with a counter) to count the clock signals generated by said clock generating unit; wherein said ID code sections (Fig. 2, sequence number generator 24; col. 7, line 54, sequential count values associated with a counter) are formed by counter values of said counter.

All subject matters except a first storing unit and a second storing unit in claims 11 are disclosed in claim 1. However, Nomura teaches, in the art of ID registration system, a first storing unit (col. 5, lines 11-24, first memory 160 subsequent to input via the ten-key into temporary memory in controller 110) and a second storing unit (col. 5, lines 11-24, input via the ten-key into temporary memory in controller 110) for the purpose of providing detailed processing.

Therefore, it would have been obvious to a person skilled in the art at the time the invention was made to include a first storing unit and a second storing unit in the

device of Marino because Marino suggest the first storing unit and Nomura teaches a first storing unit and a second storing unit for the purpose of providing detailed processing. Therefore rejection of the subject matters expressed in claims 11 are met by references and associated arguments applied to rejection of claim 1 and to additional rejection provided in the previous paragraph.

Regarding claim 12, Marino teaches a communication apparatus according to claim 11, wherein when said first control unit is set to the ID registration mode by said ID registration mode setting mechanism, said at least one operating switch is operated multiple times before the ID code sections register as said ID code (col. 8, lines 54-66, depressing three keys at once in order to trigger programming mode).

Regarding claim 13, Nomura does teach a communication apparatus according to claim 12, wherein the ID code sections are sequentially stored in said second storing unit (col. 5, lines 11-18, password number in temporary memory in the controller 110, and subsequently registered into first memory 160).

Regarding claim 14, Nomura teaches a communication apparatus according to claim 11, wherein said ID registration mode setting mechanism comprises said at least one operating switch and a mode control unit within said first control unit to set the ID registration mode from the operation of said at least one operating switch in a predetermined format (col. 5, lines 8-24, registration mode via switch 150).

Regarding claim 15, Marino teaches a communication apparatus according to claim 14, further comprising at least two operating switches, said ID registration mode setting mechanism further comprising operation of said at least two operating switches in a predetermined order (col. 2, lines 23-26, predetermined order associated

with registration mode button before receiving ID; col.3, line 6-13, operation of call via specific master by transmitting specific ID).

Regarding claim 16, Marino teaches a communication apparatus according to claim 11, said portable transmitter further comprising: a clock generating unit to generate clock signals (col. 7, lines 51-56, clock associated with a counter); and a counter (col. 7, lines 51-56, clock associated with a counter) to count the clock signals generated by said clock generating unit; wherein said ID code sections (Fig. 2, sequence number generator 24) are formed by counter values of said counter.

Regarding claims 7-8. 17-18 and 27-28, Marino in view of Nomura teaches a portable transmitter comprising a control unit comprising ID registering mode. But Marino in view of Nomura does not teach a notifying mechanism is a light-emitting diode to indicate a storage state of said ID code sections.

However, examiner takes official notice that one skilled in the art recognizes a portable transmitter comprising a notifying mechanism associated with a light-emitting diode to indicate a storage state of said ID code sections is well known feature for the purpose of providing completion of ID code input. Therefore it would have been obvious to one skilled in the art at the time of invention was made to include a portable transmitter comprising a notifying mechanism associated with a light-emitting diode to indicate a storage state of said ID code sections in the device of Marino in view of Nomura because Marino in view of Nomura suggests a portable transmitter comprising control unit comprising ID registering mode and one skilled in the art recognizes a portable transmitter comprising a notifying mechanism associated with a light-emitting

diode to indicate a storage state of said ID code sections is well known feature for the purpose of providing completion of ID code input.

Regarding claims 9-10, 19-20 and 29-30, Marino in view of Nomura teaches a portable transmitter comprising a control unit comprising ID registering mode. But Marino in view of Nomura does not teach when said first control unit is set to the ID registration mode and said at least one operating switch is not operated a single time or multiple times within a predetermined time period, said first control unit reverts out of the ID registration mode.

However, examiner takes official notice that one skilled in the art recognizes when said first control unit is set to the ID registration mode and said at least one operating switch is not operated a single time or multiple times within a predetermined time period, said first control unit reverts out of the ID registration mode is well known feature for the purpose of providing transmitter normal operation. Therefore it would have been obvious to one skilled in the art at the time of invention was made to include when said first control unit is set to the ID registration mode and said at least one operating switch is not operated a single time or multiple times within a predetermined time period, said first control unit reverts out of the ID registration mode in the device of Marino in view of Nomura because Marino in view of Nomura suggests a portable transmitter comprising control unit comprising ID registering mode and one skilled in the art recognizes when said first control unit is set to the ID registration mode and said at least one operating switch is not operated a

single time or multiple times within a predetermined time period, said first control unit reverts out of the ID registration mode is well known feature for the purpose of providing transmitter normal operation.

All subject matters in claim 21 are disclosed in claim 11, and therefore rejection of the subject matters expressed in claim 21 are met by references and associated arguments applied to rejection of claim 11.

All subject matters in claims 22-26 are disclosed in claims 12-16, and therefore rejection of the subject matters expressed in claims 22-26 are met by references and associated arguments applied to rejection of claims 12-16.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matsuichiro0 Shimizu whose telephone number is (703) 306-5841. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik, can be reached on (703-305-4704). The fax phone number for the organization where this application or proceeding is assigned is (703-305-3988).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703-305-8576).

Matuichiro Shimizu

September 17, 2004

MICHAEL HORABIK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600